

Drawings

The drawings are objected to under 37 CFR 1.83(a). The galvo motorized focusing assembly is shown in block diagram form as the motor 14, drive shaft housing 13, and drive shaft 18 which is interconnected to focusing assembly 26. The galvo motorized focusing assembly is clearly depicted in the Figures. Applicant respectfully requests withdrawal of the objection under 37 CFR 1.83(a).

Anticipation Rejection based on Kelley et al. (5923473)

Claims 1, 3-11, 13 and 16-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly et al. (5923473).

Anticipation requires that each and every element of the claimed invention be described, either expressly or inherently, in a single prior art reference. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327, 58 U.S.P.Q.2d 1545, 1552 (Fed. Cir. 2001); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, anticipation under section 102 is only valid when a reference shows exactly what is claimed; where there are differences between the references disclosures and the claim, a rejection must be based on obviousness under Section 103. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

The Action, making reference to figures 3-12, states that *Kelley* discloses the components necessary to make and use the invention as recited in claims 1, 3-11, 13 and 16-28. Applicant respectfully disagrees with this contention.

The Kelly reference is directed towards an imaging system for forming optical spot beams of different sizes on an imaging surface, whether planar or curved, including an emitter which emits an optical beam along a path which impinges upon the imaging surface downstream of a first beam focus or focal point (see Kelly, column 3, lines 8-13). As discussed in the specification, the control system 400' includes a controller 410', which is interconnected to a sensor 460 for ***detecting the positioning of the spot beam on the image plane*** 245 (see Kelly, column 10, lines 39-43). Further the specification states that the sensor 460 ***detects the positioning of a beam spot on the image plane*** 245 before and after movement of one or both of the lenses 220 and 225 to change the beam spot size at the image plane 245 (see Kelly, column 10, lines 50-53). Later the specification states that the sensor

860 *senses the position of the spot beam at the image plane* 895 with the lens 30 in the first position 840 and the second position 850, and communicates the sensed data to the controller 810 (see Kelley, column 13, lines 47-60). Although Kelly is replete with numerous other instances of a discussion of the sensor sensing the position of the spot beam at the image plane, for the sake of brevity each occurrence is not discussed.

Among other requirements, Applicant's independent claims 1 and 8 require "a feedback positioning device for determining a position of said focusing assembly." Among other requirements, Applicant's independent claims 16 and 25 each require the step of "determining a second value for the actual linear movement of said focusing assembly." Among other requirements, Applicant's independent claim 23 requires the step of "determining an actual linear movement value of said focusing assembly."

Clearly, Kelly teaches away from Applicant's invention of claims 1, 8, 16, 23 and 25 (including the rejected dependent claims). As discussed above, Kelly requires a sensor that *detects the positioning of a beam spot on the image plane*. Quite differently, Applicant's invention determines the position of *the focusing assembly*, not a beam spot on the image plane.

Assuming *arguendo* that the Kelly reference, as asserted by the Action, discloses "the components necessary to make and use the invention," such a disclosure of various components is not sufficient to establish a prima facie case of anticipation under 35 U.S.C. 102(b). It is not sufficient to constitute an anticipation that the device (the Kelly system) relied upon might, by modification be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions. See *Bianchi v. Barili*, 168 F.2d 793, 796 (9th Cir. 1948).

Applicant respectfully contends that claims 1, 8, 16, 23 and 25 (including the rejected dependent claims) are patentable over Kelly. In view of the above, Applicant respectfully requests reconsideration and that this rejection under § 102(b) be withdrawn.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

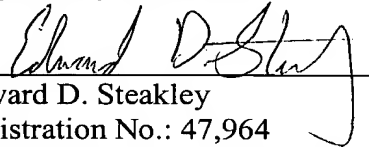
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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02306US0 from which the undersigned is authorized to draw.

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Respectfully submitted,

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